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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/019,329

Filing Date: May 09, 2002

Appellant(s): DEICHMANN ET AL.

Peter Zura
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/18/2006 appealing from the Office action
mailed 08/16/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,009,338

IWATA

12-1999

WO 98/30053 to Holmstrom et al. ("Holmstrom"), cited by the Examiner in the Office Action dated October 20, 2005.

Final Office Action dated October 20, 2005.

Advisory Action dated February 23, 2006.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmstrom et al (WO 98/30053) in view of Iwata et al. (6,009,338).

Regarding claims 9 and 15, Holmstrom discloses a mobile phone (See fig. 1), comprising: a nonvolatile memory; an SIM card; at least one electronic telephone directory, one of the at least one of the electronic telephone directory being stored in a memory of the SIM card and another of the at least one of the electronic telephone directory, if applicable, being stored in the nonvolatile memory, a number of attributes including telephone numbers and names of the at least one telephone directory being prescribed by the SIM card (See fig.1, Table 1 and page 3 lines 5-8). However, Holmstrom does not mention that at least one database stored in the nonvolatile memory, each of the at least one database being respectively assigned to one of the at least one electronic telephone directory, wherein each entry of a telephone directory

may be assigned to a corresponding database entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry and wherein the at least one database is an expansion telephone directory. Iwata teaches a mobile phone (See fig. 1) comprising an electronic telephone directory wherein each entry of a telephone directory may be assigned to a corresponding expansion telephone directory entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry (See figs. 6-7 and col. 14 line 4 to col. 15 line 13). Since both Holmstrom & Iwata teach about the mobile phone having telephone directory, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Iwata in creating expansion telephone directories for the electronic telephone directory stored in the memory of the mobile phone as disclosed by Holmstrom for the advantage of allowing users to store additional information associated with the telephone directory.

Regarding claim 10, Holmstrom & Iwata disclose as cited in claim 9. Iwata further discloses each telephone directory is assigned precisely one database (See figs. 6-7).

Regarding claim 11, Holmstrom & Iwata disclose as cited in claim 9. Iwata further discloses each database has a key (in this case, the underlined name) associated with the respective assignment between the database and the associated telephone directory (See figs. 6-7 and col. 14 line 4 to col. 15 line 13).

Regarding claims 12-14, Holmstrom & Iwata disclose as cited in claim 9. Iwata further discloses each of the database entries includes a characteristic diagram which

points to the corresponding telephone directory entry in the corresponding telephone directory, wherein the characteristic diagram of the database entry contains the corresponding telephone number and the data field of the database entry contains the additional attributes of the telephone number of the corresponding telephone directory (See fig. 7 and col. 14 line 64 to col. 15 line 13).

Regarding claim 16, Holmstrom & Iwata disclose as cited in claim 15. Iwata further discloses the expansion telephone directory stored in the nonvolatile memory differs in format (in term of the amount of data being stored) from the electronic telephone directory stored in the SIM card (See fig. 7). However, they do not mention that the expansion telephone directory being assigned by an IMSI to the electronic telephone directory. IMSI is known as an identification (or the name) of the SIM card, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to assign the expansion telephone directory to the telephone directory entry represented by the IMSI for the advantage of allowing user to store additional information associate with the SIM card.

(10) Response to Argument

With respect to the appellant's argument filed on 09/18/2006, the responses are follows:

- a. In response to applicant's argument that there is no suggestion to combine the references (See Appeal Brief, Argument section, page 10-12) the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Holmstrom discloses a mobile phone comprising at least one electronic telephone directory wherein one of the at least one of the electronic telephone directory being stored in a memory of a SIM card and another of the at least one electronic telephone directory being stored in a nonvolatile memory of the mobile phone (See page 3, Table 1 and lines 5-9) and Iwata teaches a mobile phone (See fig. 1) comprising an electronic telephone directory wherein each entry of a telephone directory (e.g. MATSUURA JIRO) (See Iwata, fig. 6) may be assigned to a corresponding expansion telephone directory (See fig. 7 and col. 14 line 4 to col. 15 line 13). Since both Holmstrom & Iwata teach about the mobile phone having telephone directory; they are combinable and their combination will create expansion telephone directory, as taught by Iwata, for the telephone directory stored in the memory of the mobile phone as disclosed by Holmstrom in order to allow users to store additional information associated with the telephone directory.

b. The Appellant argued and appeared to make a case of assigning the database stored in the non-volatile memory of the mobile phone to the electronic telephone directory stored in the memory of the SIM card (See Appeal Brief, Argument section, page 13-14). The Examiner respectfully disagrees with the Appellant's argument because the limitation "each of the at least one database being respectively assigned to one of the at least one electronic telephone directory", **wherein the**

electronic telephone directory as recited in claim 9 (“at least one electronic telephone directory, one of the at least one of the electronic telephone directory being stored in a memory of the SIM card and another of the at least one electronic telephone directory, if applicable, being stored in the non-volatile memory”) can be stored either in the memory of the SIM card or the mobile phone, is not narrow enough to prevent the database from being assigned to the electronic telephone directory of the mobile phone. In such case, it would have been obvious to one skilled in the art at the time the invention was made to create expansion telephone directory, as taught by Iwata, for the telephone directory stored in the memory of the Holmstrom's mobile phone.

c. The Appellant argued that the display in Iwata does not provide for any addition attributes (See Appeal Brief, Argument section, page 14). The Examiner respectfully disagrees with the Appellant. Iwata does disclose each entry of the telephone directory (**e.g. MATSUURA JIRO**) (See fig. 6) is assigned to a corresponding database entry having a data field of variable size with respect to a number of additional attributes (**e.g. home address, office address, company's name, home fax number, office fax number**) (See fig. 7).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Tuan Tran

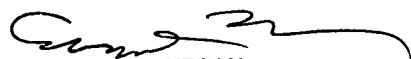
December 9, 2006

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